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10/078,051	02/15/2002	Pei-Yuan Zhou	50269-0516	6331

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EXAMINER
LOFTUS, ANN E

ART UNIT	PAPER NUMBER
3691	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.
      4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4, 6-9, 11, 15, 16, 18, 25, 29-33, 36-39, 41-44, 46, 50, 51, 53, 60, 64-68, 71-77, 84-89, 96, 98, 99, 101, and 116-123* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a)☐ All   b)☐ Some * c)☐ None of:
          1.☐ Certified copies of the priority documents have been received.
          2.☐ Certified copies of the priority documents have been received in Application No. _____.
          3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date *5/28/10*.
4) ☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6-9,11,15,16,18,25,29-33,36-39,41-44,46,50,51,53,60,64-68,71-77,84-89,96,98,99,101 and 116-123.

DETAILED ACTION

Status of the Claims

1.   This action is a response to an amendment filed 11/30/09. The application was

filed on 2/15/02 with a provisional dated **2/17/01**.

2.   The following claims are cancelled: 5, 10, 12-14, 17, 19-24, 26-28, 34, 35, 40, 45,

47-49, 52, 54-59, 61-63, 69, 70, 78-83, 90-95, 97, 100, and 102-115.

3.   The following claims are pending: 1-4, 6-9, 11, 15, 16, 18, 25, 29-33, 36-39, 41-

44, 46, 50, 51, 53, 60, 64-68, 71-77, 84-89, 96, 98, 99, 101, and 116-123.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission has been

entered.

Information Disclosure Statement

5.   The information disclosure statement (IDS) submitted on 5/28/10 is being

considered by the examiner.

Response to Arguments

6.   Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The applicant argues that the reference cited does not address the amended language. The rejections below are updated to address the amended language.

Claim Objections

7.   Claim 98 is objected to because of the following informalities: It depends on claim 97 which is canceled. The applicant (Mr. Rees) stated by phone on 5/27 that the claim should depend on claim 1, and it has been interpreted as such. Appropriate correction is required.

8.   Claims 120-123 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. . A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. MPEP 608.01(n). In this case, possession or sale of the storage medium (without execution) would infringe the dependent claims, but would not perform the method and not infringe the parent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10.   Claims 1-4, 6-9, 11, 15, 16, 18, 25, 29-33, 36-39, 41-44, 46, 50, 51, 53, 60, 64-68, 71-77, 84-89, 96, 98, 99, 101 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 38 recite: based on information other than the particular (IP) address, determining what content …is being provided by or requested from …

A review of the specification, original claims and drawings finds determining the content (original claim 1) based on the content of messages, and (page 7) inspecting the messages to see what content … It doesn't say what parts of the message are inspected or not. There is no support for "based on information other than the IP address."

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-4, 6, 8, 9, 11, 15, 16, 18, 31-33, 36-39, 41, 43, 44, 46, 50, 51, 53, 66-

68, 71-73, 75, 77, 84, 86, 88, 89, 96, 98, 99, 101, and 116-123 are rejected under 35

U.S.C. 103(a) as being unpatentable over US 2002/0131404 (09/997,402) filed

11/28/2001 (provisional 11/28/2000) by Mehta et al. in view of WO 99/31610

(PCT/GB98/03752) filed in GB 12/15/97, and published 6/24/99, by Leveridge.

As to claims 1, 38, 116, and 120, Mehta discloses recording interactions reflected

in messages in paragraph 76 page 7.

Mehta paragraph 9 page 1 discloses intercepting a message that has been sent

from a first participant to a second participant prior to said message arriving at said

second participant.

Mehta paragraph 9 page 1 discloses intercepting the message is performed by

an intercepting device deployed between the first participant and the second participant.

Mehta paragraph 9 page 1 discloses the message has the address (URL) of the

second participant, but does not disclose that the message itself is addressed to the

second participant. **Leveridge** discloses this in page 8. It would have been obvious to a

person of ordinary skill in the art at the time of the invention to modify Mehta to add the

message is addressed to the second participant in order to make it quick and easy to

retransmit.

Mehta paragraph 9 page 1 discloses the message includes requestor identifier

information and provider identifier information, the first participant is one of a requestor

and a provider, and the second participant is the other of the requestor and the provider.

Mehta paragraph 9 page 1 discloses the message is addressed to or addressed from a particular address,

Mehta paragraph 9 page 1 discloses the particular address being a unique Internet Protocol address, and the particular address is associated with the provider (a URL includes an IP address).

Mehta paragraph 9 page 1 the intercepting device is managed by a third party that is different from the requestor and the provider

Mehta paragraph 9 page 1 discloses based on the intercepted message, software managed by the third party and wherein the method is performed by one or more computer devices. (MAS).

Mehta paragraph 9 page 1 discloses determining what content of the plurality of different types of content provided by the provider at the particular address, is being provided by or requested from the provider in the message

Mehta discloses determining the content based on the information in the message other than the particular address (Java classes) in paragraph 92 page 10.

Mehta discloses in paragraph 60 page 4 the provider provides a plurality of different types of content in response to requests addressed to the particular address.

Mehta paragraph 84 page 9 discloses determining the identity of the requestor based on the requestor identifier information in the message

Mehta paragraphs 76-77 pages 7-8 discloses determining whether the content has billing implications and if the content has billing implications, sending billing data to a billing service, the billing data being based on the determined content

Mehta discloses in paragraph 97 page 11 determining the identity of the provider

based on the provider identifier information (verifying the signature) in the message.

As to claims 2, 88, 117 and 121, Mehta discloses in paragraph 76 page 7

determining that the content is being or has been provided to the requestor by the

service provider through the intercepted message, and sending data to the billing

service occurs in response to this determining.

As to claim 3 Mehta discloses in Fig 10k the third party performs the step of

billing on behalf of the provider.

As to claims 4 and 39, Mehta discloses in paragraph 76 page 7 using the log to

charge a particular participant for content indicated in the message, wherein said

particular participant is one of said first participant and second participant.

As to claims 6 and 41, Mehta discloses in paragraphs 76 and 77, pages 7-8 the

log includes information to indicate how much the first participant or the second

participant is to pay for the content. Note that "information to indicate" is broader than a

price or amount to charge. However, Mehta recites prepaid accounts stored and

maintained by the Billing Manager; in this case the Billing Manager would have to have

price information to correctly debit the accounts.

As to claims 8 and 43, Mehta discloses in paragraph 86 page 9 determining that

a particular participant of the first participant and second participant must pre-pay for the

content, and determining whether the particular participant has sufficient funds to pay

for the content; and determining how to handle said message based on whether said particular participant has sufficient funds to pay for the content.

As to claims 9 and 44, Mehta discloses determining that the requester must pre-pay for the content in paragraph 86 page 9. The information used to determine this is billing information. Mehta discloses in paragraph 98 page 11 billing information in a profile. Mehta's profiles are application profiles, but applications are associated with providers through the URLs, and so the profile is associated with a provider.

As to claims 11, 46, 118 and 122, Mehta discloses a message is a response from a provider in paragraph 140 page 18. Mehta discloses a message from the provider includes a price at which the provider is willing to provide the content in paragraph 98 page 11.

As to claims 15 and 50, Mehta paragraph 108 page 12 discloses updating a requestor profile based on the content that is requested.

As to claims 16 and 51, Mehta discloses in paragraph 77 page 8 decrementing an account balance of the first participant or second participant when the requestor accesses the content.

As to claim 18 and 53, Mehta discloses page 7 paragraph 72 locating a profile based on the identity of the first participant.

As to claims 31, 33, 66, and 68, Mehta discloses in paragraph 86 page 9 determining whether the requestor has funds to pay for the content based on an authorization source, and the authorization source is one of a profile, a billing system, and a billing scheme of an access provider.

As to claim 32, and 67, Mehta discloses paragraph 77 page 8 if the requestor has the funds, causing the funds to be decremented from a requestor account associated with the requestor.

Mehta does not disclose retransmitting the message to the provider to obtain the content for the requestor. Leveridge discloses on page 8 retransmitting the message to the provider to obtain the content for the requestor. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Mehta to add this feature in order to make it quick and easy to retransmit.

As to claim 36 and 71, Mehta discloses determining whether the provider is an authorized partner in paragraph 91 pages 9-10 and 135 pages 16 and 17. Mehta does not disclose retransmitting the message to the provider to obtain the content for the requestor. Leveridge discloses on page 8 retransmitting the message to the provider to obtain the content for the requestor. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Mehta to add this feature in order to make it quick and easy to retransmit.

As to claims 37 and 72, Mehta discloses determining whether the content involves a fee in paragraph 135 page 7. Mehta paragraph 98 page 11 discloses the provider suggesting a price. Mehta discloses storing data in profiles in paragraph 73 page 7. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the suggested price could be stored in a provider profile, and then the profile would be inspected to determine if the content involves a fee. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine

these disclosures with predictable results and a reasonable expectation of success, in

order to have an organized way of storing the information to make access easier and

faster.

Mehta discloses establishing a secure connection in paragraph 13 page 2, and

authenticating the provider by using an authentication mechanism (logging into an

account) in paragraph 97 page 11.

As to claims 73 and 84, Mehta discloses in paragraph 76 page 7 generating a log

of the message, wherein the data sent to the billing service is based on the log.

As to claims 75 and 86, Mehta discloses in paragraph 76 page 7-8 the

intercepting device generates the log without determining whether the message has

billing implications, and determining whether the message has billing implications

further comprises analyzing the log of said message.

As to claims 77, 89, 119 and 123, Mehta discloses in paragraph 114 page 14

billing the provider for providing the content (paying advertiser).

As to claims 96 and 99, Mehta discloses in paragraph 90 page 9 the first

participant is a provider and the second participant is the requestor.

As to claim 98 and 101, (interpreted as dependent on claim 1, rather than 97

which is cancelled) Mehta discloses the provider identifier information is the address

and the information based upon which the content is determined includes a URL path.

13.   Claims 7, 42, 76 and 87 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mehta in view of Leveridge as applied above, further in view of US

Patent 6873691 filed 4/6/99 by Malik.

As to claims 7 and 42, Mehta does not teach reading a plurality of logs at an

aggregation engine that places access information contained in said logs into the format

required by a billing system. Malik teaches in col 17 line 40 to col 18 line 37 reading a

plurality of logs at an aggregation engine that places access information contained in

said logs into the format required by a billing system. It would have been obvious to a

person of ordinary skill in the art at the time of the invention to modify Mehta to add

reading a plurality of logs at an aggregation engine that places access information

contained in said logs into the format required by a billing system in order to condense

the message data into a more useful form and save storage.

As to claim 76 and 87, Mehta does not teach an aggregation engine. Malik

teaches an aggregation engine in col 17 line 40 to col 18 line 37. It would have been

obvious to a person of ordinary skill in the art at the time of the invention to modify

Mehta to add an aggregation engine in order to consolidate the transaction information

and save space.

14.   Claims 25 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mehta in view of Leveridge as applied above, in view of US Patent No. 5502636

filed Jan 31, 1992 by Clarke.

As to claims 25 and 60, Mehta does not specifically teach updating the profile to award the service requestor a prize for having requested said service. Clarke in claims 6, 18 and 19 teaches updating the profile to award the service requestor a prize (coupon) for having requested said service (subscription). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Mehta to add updating the profile to award the service requestor a prize for having requested said service because it helps to motivate repeat business.

15.   Claims 29, 30, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta in view of Leveridge as applied above and further in view of US Patent No. 6704612 filed 12 May 1999 by Hahn-Carlson, hereafter known as Hahn.

As to claims 29, 30, 64, and 65, Mehta does not specifically teach inspecting a profile to determine whether the service requestor requires pre-authorization for the service, and sending the service requestor a payment authorization message.

Hahn teaches inspecting a profile to determine whether the requestor requires pre-authorization for the content in claims 1, 11 and 16. Hahn teaches in col 11 line 45 to col 12 line 5 sending a payment authorization request and receiving a payment authorization. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Mehta to add inspecting a profile to determine whether the service requestor requires pre-authorization for the service, sending the service requestor a payment authorization request message, and receiving a payment

authorization in order to document a purchaser's agreement to pay and avoid denial of

payment later.

16.   Claims 74 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mehta in view of Leveridge as applied above, further in view of US 5,963,625 filed

9/30/96 by Kawecki.

As to claims 74 and 85, Mehta discloses in the abstract the software managed by

the third party is executed by the intercepting device in the abstract. Mehta discloses

software determining that the message has billing implications in paragraph 77 page 8.

Mehta discloses in paragraph 81 page 8 an ability to limit the logging steps. Mehta does

not disclose generating a log in response to determining that the message has billing

implications. Kawecki discloses in col 8 line 57 to col 9 line 18 generating the log of the

message occurs in response to the software determining that the message has billing

implications. It would have been obvious to a person of ordinary skill in the art at the

time of the invention to modify Mehta to add generating the log of the message occurs

in response to the software determining that the message has billing implications in

order to avoid overloading the log.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure: US 6,868,267 by Briggs et al.; US 6, 199,054 by Khan et al., and

US 2003/0005878 by Olin et al.

18.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ann Loftus whose telephone number is 571-272-7342.

The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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AL

/Lalita M Hamilton/

Primary Examiner, Art Unit 3691